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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/521,005	03/07/2000	Michael R. Pallesen	M-8036 US	1151

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EXAMINER

BLECK, CAROLYN M

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 11/03/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/521,005

Applicant(s)

PALLESEN ET AL.

Examiner

Carolyn M Bleck

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 14-24 and 26-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14-24, and 26-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the response filed 26 August 2003. Claims 1-12, 14-24, and 26-36 are pending. The claims have not been amended.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-6, 8-9, 11-12, 14-18, 20-24, 26-30, and 32-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dworkin (4,992,940) in view of Kennedy (5,787,453), for substantially the same reasons given in the previous Office Action (paper number 13).

(A) Claims 1-6, 8-9, 11-12, 14-18, 20-24, 26-30, and 32-36 have not been amended and are rejected for the same reasons given in the prior Office Action (paper number 13; section 7(A)-7(Q); pages 2-10).

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4. Claims 7, 10, 19, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dworkin (4,992,940) and Kennedy (5,787,453) as applied to claims 1, 15, and 27 above, and further in view of Bosco et al. (5,191,522), for substantially the same reasons given in the previous Office Action (paper number 13).

(A) Claims 7, 10, 19, and 31 have not been amended and are rejected for the same reasons given in the prior Office Action (paper number 13; section 8(A); pages 11-12).

Response to Arguments

5. Applicant's arguments filed 26 August 2003 have been fully considered but they are not persuasive. Applicant's arguments will be addressed below in the order in which they appear in the 26 August 2003 response.

(A) At pages 2-3 of the 26 August 2003 response, Applicant argues that the applied references do not teach or suggest product rate information including at least one product rate expression.

In response, the Examiner respectfully submits that Dworkin teaches the following:

a terminal for communicating over a modem with the computer storing the database, wherein the computer accepts inputs from the user, searches the database, and displays the results to the user on the terminal, wherein the database contains information about products and/or services and the vendors who sell them, including a

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number which identifies the product, the lowest price available among all the vendors in the database, the average price for the product for all vendors in the database, and the list price for the product, wherein the entries for lowest price and the average price are calculated anew for each search by a user by searching the database for each vendor selling a particular item, and noting the price offered by each vendor, including possible quantity discounts, and wherein shipping charges are also calculated for a product by including in the database a detailed table giving shipping charges, as established by a common carrier, for every combination of shipping weights and distances, and then determining the shipping charges by consulting the stored table and calculating an amount based on distance and time and then displaying the shipping charge to the user (Fig. 1-2, 6, col. 3 line 60 to col. 4 line 35, col. 5 lines 35-68, col. 6 lines 11-44 and lines 58-65, col. 7 lines 35-54, and col. 8 lines 38-56) (It is noted that in Figure 1 the CPU and database are in communication with each other, and therefore this is considered to be a form of a "database interface").

Based on the above passages cited from Dworkin, it is respectfully submitted that in order to calculate a price for a product Dworkin's system performs the following calculation, a form of "product rate expression":

$$\begin{aligned} &(\text{original price for the item}) - (\text{discounts based on quantity}) + (\text{shipping} \\ &\text{destination surcharges}) + (\text{shipping weight surcharges}) = \text{total price.} \end{aligned}$$

Dworkin then discloses providing the total price to a user (Fig. 1-2, 6, col. 3 line 60 to col. 4 line 35, col. 5 lines 35-68, col. 6 lines 11-44 and lines 58-65, col. 7 lines 35-54, and col. 8 lines 38-56). The total item or product price calculated from the

aforementioned equation is considered to be "product rate information, including at least one product rate expression."

Thus, it is the position of the Examiner that Dworkin teaches the limitation recited in claim 1 of "a database interface operable to request and receive product rate information from a database, the product rate information including at least one product rate expression."

Furthermore, it is noted that Applicant provides no strict definition of the term "product rate expression." Therefore, the Examiner has given the claims their broadest reasonable interpretation (see MPEP 2111). Further, although it is proper to use the specification to interpret what the applicant meant by a word or phrase recited in the claim, it is **not** proper to read limitations appearing in the specification into the claim when these limitations are not recited in the claim. *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994); *Intervet America Inc. v. Kee-Vet Lab. Inc.*, 887 F.2d 1050, 1053, 12 USPQ2d 1474, 1476 (Fed. Cir. 1989). If Applicant requires a strict definition of the term, it is suggested the Applicant amend the claims to better reflect what applicant intends to claim as the invention.

(B) At pages 3-4 of the 26 August 2003 response, Applicant argues that the applied references do not teach or suggest a product rate information cache storing product rate information.

In response, the Examiner submits that Dworkin teaches a computer connected to a database, wherein the database is stored in the memory of the computer (col. 3

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lines 60-69), wherein data is retrieved from a database and displayed (col. 11 lines 1-17). Although Dworkin does not explicitly recite "a cache", it is the position of the Examiner that one skilled in the art would have realized that when retrieving data from a database, and then performing any operation on the data such as printing or viewing the data using a printer or computer screen, it would be required by the computer to store the data in the memory of the computer, such as in a printer buffer, video memory, or the RAM of computer, after retrieving it from the database (i.e., a cache) in order to print or view the data.

(C) At page 4 of the 26 August 2003 response, Applicant argues that the applied references do not teach or suggest a client interface to provide the product rate to a client application running on a computer system.

In response, the Examiner submits that Dworkin teaches a terminal for displaying the products to the user, including the price of the product (Fig. 1, and 3-8, col. 11 lines 13-16), wherein a program is used for accepting inputs from a user through a terminal (Fig. 1-2A-2B, 6, col. 3 line 60 to col. 4 line 35, col. 5 lines 35-68, col. 6 lines 1-44 and lines 58-65, col. 8 lines 38-56, col. 10 line 65 to col. 12 line 40). Thus, it is the position of the Examiner that Dworkin teaches the feature of a client interface (Dworkin's "terminal") to provide the product rate to a client application running on a computer system (Dworkin's "program").

(D) At pages 4-5 of the 26 August 2003 response, Applicant argues that there is no suggestion or motivation to combine Dworkin and Kennedy.

In response to applicant's argument that there is no suggestion or motivation to combine Dworkin and Kennedy, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Furthermore, the Examiner realizes that each applied reference does not expressly suggest combination with the other respective reference; however, the Examiner has clearly shown that motivation for combining or modifying the applied references existed in the prior art as shown at pages 4-5 of the previous Office Action. In addition, all the modifications proposed by the Examiner are taught by the applied references and that knowledge generally available to one of ordinary skill in the art. Therefore, the combination of references is proper and the rejection is maintained.

(E) Applicant's remaining arguments given at page 5 of the response filed 26 August 2003 rely upon or rehash the issues addressed above, and are therefore moot in view of the responses given in sections 5(A)-5(D) above, and incorporated herein.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (703) 305-3981. The Examiner can normally be reached on Monday-Thursday, 8:00am – 5:30pm, and from 8:30am – 5:00pm on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (703) 305-9588.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 306-1113.

8. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

(703) 872-9306 or (703) 872-9326 [Official communications]


(703) 872-9327 [After Final communications labeled "Box AF"]

(703) 746-8374 [Informal/ Draft communications, labeled
"PROPOSED" or "DRAFT"]

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,
Arlington, VA, 7th Floor (Receptionist).



CB
October 23, 2003



JOSEPH THOMAS
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